

### **REMARKS**

The Applicant notes with appreciation the Examiner's thorough review of the present application as evidenced by the Office Action.

This amendment and the following remarks are submitted in response to the Office Action dated December 8, 2004. In light of the amendments submitted and the remarks that follow, the Applicant respectfully submits that all the claims of the application are patentable and in condition for immediate allowance.

#### Claim Amendments

The claims have been amended to more clearly recite the invention, with support in the specification and drawing. For example, independent claims 1 and 16 have been amended to recite a writing surface that is generally planar and made for receiving both temporary and permanent indicia. The features of the slot have been amended so that a majority of the writing surface extends beyond the edge when the label assembly is placed on the wall of an open container, as described in the specification and drawing. The orientation of the slot is generally parallel to the writing surface, as shown in the drawing figures.

#### Claim Rejections – 35 U.S.C. § 112

The Examiner rejected claims 3 and 8 under Section 112, second paragraph, based upon a lack of antecedent basis. Claims 3 and 8 have been canceled.

Claim Rejections – 35 U.S.C. § 102

The Examiner rejected claims 1, 3, 8, 10 and 12, under Section 102(b), as being anticipated by U.S. Patent 5,829,832 issued to *Molee, et al.* To anticipate a claim, the cited reference must teach every element of the claim. See MPEP 2131; *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

The claims, as amended, recite elements and features that are not taught or disclosed by *Molee*. For example, as recited in independent claims 1 and 16, as amended, the claimed writing surface is generally planar. Also, a majority of the writing surface extends beyond the edge when the label assembly is placed on the wall of an open container. Because *Molee* does not teach or disclose every element recited in the claims, as amended, the Applicant submits the claims are not anticipated.

Claim Rejections – 35 U.S.C. § 103(a)

In general, a proper rejection under 35 U.S.C. § 103(a) requires that: (1) the prior art references teach or suggest all of the features of the claimed invention; (2) there is some suggestion or motivation to modify or combine the prior art references; and, (3) there is a reasonable expectation of success in combining the prior art references. See MPEP 2142; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

First, in response to each 103 rejection, the independent claims 1 and 16, as amended, recite elements and features that are neither taught nor suggested by *Molee*, either alone or in combination with any of the cited references. The dependent claims include the patentable subject matter in the claims from which they depend.

Second, and more specifically, the Applicant responds to the obviousness rejections below, using the Examiner’s numbered paragraphs as a reference.

¶ 7. The Examiner rejected claims 9, 11, 13, 16, 18, 19, and 23-26, under Section 103(a), on the grounds that the invention as claimed is obvious in light of *Molee, et al.*

Independent claim 16, as amended, recites elements and features that are neither taught nor suggested by *Molee*. Claims 9, 18, and 19 have been canceled. The dual slots recited in claims 11 and 24, as amended, include features that are neither taught nor suggested in *Molee*. The remaining rejected dependent claims include features in the claims from which they depend that are neither taught nor suggested in *Molee*.

¶ 12. The Examiner rejected claims 4-7 and 20-22, under Section 103(a), on the grounds that the invention as claimed is obvious in light of *Molee, et al.*, in view of U.S. Patent 5,581,921 issued to *Hutchens*.

These rejected dependent claims 4-7 and 20-22, as amended, recite an elongate projection to help prevent inadvertent erasure of temporary indicia on a writing surface. Neither *Molee* nor *Hutchens* teaches or suggests a writing surface, a writing surface for temporary indicia, or the use of a projection to protect temporary indicia. Instead, *Molee* and *Hutchens* disclose supports for printed, permanent advertisements and brand logos. The projection described in *Hutchens*, such as stabilizer member 22, is directed toward the structure of the fastener or the positioning of the brand sign 2 with respect to the pitcher (column 2, line 66, through column 3, line 10; Figure 3). The disclosure of stabilizing structural elements in *Hutchens* teaches nothing about the protection of temporary indicia as provided by the elements recited in claims 4-7 and 20-22.

¶ 15. The Examiner rejected claims 14 and 27, under Section 103(a), on the grounds that the invention as claimed is obvious in light of *Molee, et al.*, in view of U.S. Patent 5,384,999 issued to *Roche, et al.*

Neither *Molee* nor *Roche* teach or suggest a magnetic layer for a writing surface having the features recited in claims 14 and 27 and the claims from which they depend; 1 and 16, respectively. The features of the claimed writing surface are not taught or suggested by the wall

panels in *Roche* or the towel retainer in *Molee*, either separately or in combination. Moreover, there is no suggestion or motivation in the references to combine the features of a wall panel and a towel retainer, nor would such a combination produce a writing surface as claimed.

¶ 17. The Examiner rejected claims 2, 15, 17 and 28, under Section 103(a), on the grounds that the invention as claimed is obvious in light of *Molee, et al.*, in view of U.S. Patent 5,727,818 issued to *Schmeida*.

The prior art does not disclose or suggest a dry-erase whiteboard for a writing surface having the features recited in claims 2 and 17 and the claims from which they depend; 1 and 16, respectively. Neither *Molee* nor *Schmeida* teach or suggest a dry-erase whiteboard as claimed. Moreover, because *Molee* does not include a writing surface for temporary indicia, there would be no motivation to combine the permanent advertising surface in *Molee* with the temporary labels in *Schmeida*.

The prior art also does not disclose or suggest a film for protecting a writing surface having the features recited in claims 17 and 28 and the claims from which they depend; 1 and 16, respectively. Neither *Molee* nor *Schmeida* teach or suggest a film for a writing surface as claimed.

### CONCLUSION

After entry of the requested amendment, claims 1, 2, 4-7, 10-17, and 20-28 are pending in the application. In light of this amendment and the remarks presented, the Applicant respectfully submits that all the claims of the application are patentable and the application is now in condition for allowance.

The undersigned is available at (404) 881-7821 if the Examiner has any questions or requests that may be resolved by telephone in order to expedite the examination.

The Applicant includes herewith a Petition and Fee for Extension of Time for a total period of one month.

The Applicant does not believe any request for extension of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. In the event, however, that additional extensions of time are necessary to allow the consideration of this paper, such extensions are hereby petitioned-for under 37 CFR § 1.136(a) and any fee required therefor (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



J. Scott Anderson  
Registration No. 48,563

J. SCOTT ANDERSON  
1214 Hillwood Court SE  
Atlanta, Georgia 30316-2660  
Daytime (404) 881-7821  
Wireless (404) 245-5718  
Direct Fax (404) 253-8349

#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to **Mail Stop Amendment**, Commissioner for Patents, Post Office Box 1450, Alexandria, Virginia 22313-1450, on this, the 8 day of April, 2005.

  
J. Scott Anderson